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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/655,531	09/05/2003	Jose Remacle	035642-0103	5573

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EXAMINER

STEELE, AMBER D

ART UNIT PAPER NUMBER

1639

DATE MAILED: 02/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/655,531	<b>Applicant(s)</b> REMACLE ET AL.	
	<b>Examiner</b> Amber D. Steele	<b>Art Unit</b> 1639	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-30 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

**DETAILED ACTION**

***Status of the Claims***

1. Claims 1-30 are currently pending.

***Election/Restrictions***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-9 are drawn to a method of analyzing activation pathways, classified in class 435, subclass 6.
  - II. Claims 10-19 are drawn to a method of evaluating the activity of a chemical compound, classified in class 436, subclass 518.
  - III. Claims 20-22 are drawn to a method of identifying a compound, classified in class 435, subclass DIG 17.
  - IV. Claims 23-29 are drawn to a microarray, classified in class 436, subclass 524.
  - V. Claim 30 is drawn to a diagnostic kit/apparatus, classified in class 435, subclass 287.2.
3. The inventions are independent and/or distinct, each from the other because of the following reasons:
  - A. Groups I-III represent separate and patentably distinct inventions. Groups I-III are drawn to different methods that are directed to different purposes, recite different method steps, and/or use different materials. For example, Group I requires the method step of obtaining a nucleic acid from a biological sample which is not required by either of Groups II-III and Group II requires evaluating the activity of a chemical compound on

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brain tissue which is not required by either of Groups I or III. Therefore, Groups I-III have different issues regarding patentability and enablement. Additionally, Groups I-III represent patentably distinct subject matter which merits separate and burdensome searches. Art anticipating or rendering obvious Group I would not necessarily anticipate or render obvious Group II or III and *vice versa*, because they are drawn to different inventions that have different distinguishing features. Furthermore, Groups I-III have a separate status in the art as shown by the different classification (e.g. class and/or subclass; please refer to section 2).

B. Inventions IV (product) and I-III (processes) are related as product and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case, the product as claimed can be used in a materially different process (e.g. a method of screening a library of peptides for binding to amine neurotransmitter receptors). Furthermore, Groups I-III are drawn to methods that are separate and patentably distinct inventions (please refer to section 3 A above).

C. Inventions I-III (processes) and V (apparatus) are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the apparatus as claimed can be

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used to practice another and materially different process (e.g. screening proteins or chemical compounds). Furthermore, Groups I-III are drawn to methods that are separate and patentably distinct inventions (please refer to section 3 A above).

D. Inventions IV (product) and V (apparatus) are related as product and an apparatus comprising the product. The inventions are distinct if it can be shown that either: (1) the product as claimed can be utilized by another and materially different apparatus, or (2) the apparatus as claimed can be used with a different product. (MPEP § 806.05(e)). In this case, the product as claimed can be utilized by another and materially different apparatus (e.g. a kit for identifying a compound useful for treating a neurological disorder) and the apparatus as claimed can be used with a different product (e.g. a microarray with amine neurotransmitter receptors, nucleic acids encoding proteins important in diagnosing cancer, and proteins important in diagnosing viral infections).

4. Because these inventions are distinct for the reasons given above and:
  - a. have acquired a separate status in the art as shown by their different classification (please refer to section 2), and/or
  - b. divergent subject matter which would require different bibliographic and/or classification searches; and/or
  - c. because the inventions have acquired a separate status in the art because of the recognized divergent subject matter, restriction for examination purposes as indicated is proper.

***Species Election***

5. This application contains claims directed to the following patentably distinct species of the claimed inventions for Groups I-V. Election is required as follows.

6. If applicant elects the invention of **Group I**, the applicant is required to elect a single, specific species from **each** of the following species A-D.

A. species of capture probe

Applicant must elect, for the purposes of search, a **single, specific species** of capture probe.

B. species of what capture probes are derived from

Applicant must elect, for the purposes of search, a **single, specific species** of what capture probes are derived from.

C. species of target nucleic acid

Applicant must elect, for the purposes of search, a **single, specific species** of target nucleic acid.

D. species of label

Applicant must elect, for the purposes of search, a **single, specific species** of label.

It would necessarily be unduly burdensome to search each of the above species of the presently claimed methods since it would entail different and separately burdensome manual/computer bibliographic searches in the patent and nonpatent literature databases and/or

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additionally a reference against one species may not necessarily anticipate or render obvious the other and/or the different species may elicit different issues under 35 U.S.C. 112.

7. If applicant elects the invention of **Group II**, the applicant is required to elect a single, specific species from **each** of the following species A-E.

A. species of capture probe

Applicant must elect, for the purposes of search, a **single, specific species** of capture probe.

B. species of what capture probes are derived from

Applicant must elect, for the purposes of search, a **single, specific species** of what capture probes are derived from.

C. species of target nucleic acid

Applicant must elect, for the purposes of search, a **single, specific species** of target nucleic acid.

D. species of label

Applicant must elect, for the purposes of search, a **single, specific species** of label.

E. species of tissue

Applicant must elect, for the purposes of search, a **single, specific species** of tissue.

It would necessarily be unduly burdensome to search each of the above species of the presently claimed methods since it would entail different and separately burdensome manual/computer bibliographic searches in the patent and nonpatent literature databases and/or

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additionally a reference against one species may not necessarily anticipate or render obvious the other and/or the different species may elicit different issues under 35 U.S.C. 112.

8. If applicant elects the invention of **Group III**, the applicant is required to elect a single, specific species from **each** of the following species A-B.

A. species of capture probe

Applicant must elect, for the purposes of search, a **single, specific species** of capture probe.

B. species of disease

Applicant must elect, for the purposes of search, a **single, specific species** of disease.

It would necessarily be unduly burdensome to search each of the above species of the presently claimed methods since it would entail different and separately burdensome manual/computer bibliographic searches in the patent and nonpatent literature databases and/or additionally a reference against one species may not necessarily anticipate or render obvious the other and/or the different species may elicit different issues under 35 U.S.C. 112.

9. If applicant elects the invention of **Group IV**, the applicant is required to elect a single, specific species from **each** of the following species A-C.

A. species of capture probe

Applicant must elect, for the purposes of search, a **single, specific species** of capture probe.



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B. species of what capture probes are derived from

Applicant must elect, for the purposes of search, a **single, specific species** of what capture probes are derived from.

C. species of solid support

Applicant must elect, for the purposes of search, a **single, specific species** of solid support.

It would necessarily be unduly burdensome to search each of the above species of the presently claimed methods since it would entail different and separately burdensome manual/computer bibliographic searches in the patent and nonpatent literature databases and/or additionally a reference against one species may not necessarily anticipate or render obvious the other and/or the different species may elicit different issues under 35 U.S.C. 112.

10. If applicant elects the invention of **Group V**, the applicant is required to elect a single, specific species from **each** of the following species A-B.

A. species of capture probe

Applicant must elect, for the purposes of search, a **single, specific species** of capture probe.

B. species of what capture probes are derived from

Applicant must elect, for the purposes of search, a **single, specific species** of what capture probes are derived from.

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It would necessarily be unduly burdensome to search each of the above species of the presently claimed methods since it would entail different and separately burdensome manual/computer bibliographic searches in the patent and nonpatent literature databases and/or additionally a reference against one species may not necessarily anticipate or render obvious the other and/or the different species may elicit different issues under 35 U.S.C. 112.

11. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and **a listing of all claims readable thereon, including any claims subsequently added**. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

12. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

13. Should applicant traverse on the grounds that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

14. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement may be traversed (37 CFR 1.143). Because the above restriction/election requirement is complex, a telephone call to applicant to request an oral election was not made. See MPEP § 812.01.

15. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

16. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. Process claims that depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined

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claims must meet all the criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained.

Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996. Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. Failure to do so may result in a loss of the right to a rejoinder. Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

### ***Future Correspondences***

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amber D. Steele whose telephone number is 571-272-5538. The examiner can normally be reached Monday through Friday from 9:00 AM to 5:00 PM.

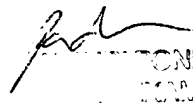
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached at 571-272-0811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ADS



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EXAMINER

February 21, 2006